

Application No.: 09/647748

Case No.: 54030US008

### Remarks

Claims 1-3, 5, and 6 are pending. Claims 4 and 6 have been canceled. Claims 1 and 2 have been amended. Claims 7-9 have been added.

Claims 1 and 2 have been amended to clarify that the first paper layer must contain short fibers, while the inclusion of short fibers in the second layer is optional. Regardless of whether short fibers are present in the second layer, both claims 1 and 2 require that the ratio of short fibers to wood pulp in the first layer be greater than the ratio of short fibers to wood pulp in the second layer. Support for the amendments can be found in, e.g., Examples 1 and 2.

Please cancel claim 6.

Claims 7-9 have been added. Support for claims 7 and 9 can be found at, e.g., Example 1. Support for claim 8 can be found at, e.g., page 3, lines 20-24.

### Interview Summary

Applicants had two telephone interviews with the Examiner on March 8, 2004 and a continuation on March 11, 2004. The Applicants discussed the nature of the 35 USC § 112 rejections with the Examiner. The Examiner agreed that the "comprising" clause in the claims was indeed proper and limited the short fibers to include, at least, the materials recited in the claims. No agreement was reached upon the patentability of the claims pending.

### § 112 Rejections

Claims 1-3, 5, and 6 stand rejected under 35 USC § 112, first paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 6 has been canceled, rendering the rejection of claim 6 moot.

According to the Patent Office, the amount of short fibers set forth in the two Markush groups are critical or essential to the practice of the invention, but not included in the claims. The Patent Office also asserted that the "comprising" clause reads on embodiments which

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possess only trace amounts of the fibers set forth in the two Markush groupings and as such render the instantly claimed invention unduly broad. (Office Action dated 01/06/2004, ¶ 4.)

Applicant respectfully submits that the claims are enabled by the disclosure, as required by 35 U.S.C. § 112, first paragraph. First, breadth of claim is not to be equated with indefiniteness. (MPEP § 2173.04.) Second, according to MPEP § 2164.08(c), “[a] feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. § 112.” (Emphasis added.) Applicant respectfully submits the Patent Office has failed to provide a basis for concluding that the amount of short fiber in either the first or second layer individually is critical. Applicant notes, for example, that in some embodiments no short fibers are required in the second layer. (See, e.g., Examples 1 and 2.)

In summary, Applicant has taught that the blending ratio in the first layer must be higher than the blending ratio in the second layer, and this feature is present in the claims as amended. Applicant respectfully submits that requiring specific levels of short fiber in each layer is unwarranted and would unduly limit the claims.

In summary, Applicant submits that the rejection of claims 1, 2, and 5 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

### **§ 103 Rejections**

Claims 1-3, 5, and 6 stand rejected under 35 USC § 103(a) as being unpatentable over Nitto Denko Corp. (XP002112333 & JP 151427) in view of Canary (EP 0 488 727 A). Claim 6 has been canceled, rendering the rejection of claim 6 moot.

According to the Patent Office, the use of the word “comprising” before a Markush group to describe short fibers was improper, and failed to exclude the wood pulp fiber taught by Canary. (Office Action dated 01/06/2004, ¶ 5.)

Applicant notes that this issue was discussed in a phone interview with the Examiner on March 8, 2004. In a second phone interview on March 11, 2004, the Examiner acknowledged that the use of the term “comprising” with the two Markush groupings was proper and distinguished the present claims from Canary. Thus, the rejection of claims 1-3, and 5 under 35

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USC § 103(a) as being unpatentable over Nitto Denko Corp. in view of Canary is unwarranted and should be withdrawn.

New claims 7-9 each depend, directly or indirectly, from claim 2, and add additional features thereto. Claim 2 is patentable for the reasons given above. Thus, claims 7-9 are likewise patentable.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of all pending claims, as amended, at an early date is solicited.

Respectfully submitted,

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Date

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